

Application No.: 10/081,564  
Amendment and Response dated December 24, 2003  
Reply to Office Action of October 3, 2003  
Docket No.: 500-151  
Page 7

### **REMARKS**

Claims 1-24 remain in this application. Claims 1-5, 7, 16-20, 23 and 24 have been amended. Applicants respectfully request reconsideration in view of the following remarks.

#### **Applicants' Response to Rejections Under 35 U.S.C. §112**

Claims 1-22 and 24 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

With respect to claims 1 and 19, Applicants respectfully traverse the Examiner's rejection of the term "cure system." Applicants submit that the disclosure at pages 11-12 of the specification clearly sets forth the meaning of a "cure system," as recited in Applicants' claims. In particular, the specification describes a "cure system" as a system which initiates cure by electromagnetic radiation. The system includes various components, such as photoinitiators, stabilizers, inhibitors and chelating agents.

With respect to claims 2-5, Applicants respectfully submit that the disclosure at pages 7-10 of the specification describes the urethane acrylate oligomer as including di- or poly-functional urethane acrylate components, as well as mono-functional urethane acrylate components. These components all are urethane acrylates, and thereby all contain urethane groups.

Applicants have amended claims 2-5, 16 and 17 to set forth the basis for the recited weight percents. In particular, the weight percents are based upon the total curable composition, as supported by disclosure at pages 10-12 of the specification.

With respect to claim 7, Applicants have amended the claim to remove the term "based," and thereby respectfully submit that the rejection has been overcome. Applicants submit that

Application No.: 10/081,564

Amendment and Response dated December 24, 2003

Reply to Office Action of October 3, 2003

Docket No.: 500-151

Page 8

“based” meant any aliphatic urethane acrylates containing an ester group. The amendment does not narrow the scope of the claim. Aliphatic urethane acrylates which contain ester groups are encompassed by the scope of the amended claim.

Applicants have amended claims 16 and 17 to more clearly set forth the weight percents and their basis. In particular, claim 16 recites a reactive plasticizer or diluent, which is present in amounts of about 0.5 to 43% in the total curable composition. Claim 17 recites a specific reactive plasticizer, 2(2-ethoxyethoxy)-ethyl acrylate, which is present in amounts of about 5-10% in the total curable composition, thereby falling within the scope of the range recited in claim 16. These amendments are supported by disclosure at page 11 of the specification.

Applicants have amended claim 20 to remove the language “to a desired thickness,” thereby overcoming the Section 112 rejection based thereon.

Applicants have amended claim 24 to correct the antecedent basis problem. In particular, element (c) has been amended to initially recite a “soft tip” rather than a “tip,” thereby providing the requisite antecedent basis.

Therefore, in view of the amendments to the claims and above remarks, Applicants respectfully request withdrawal of the Section 112, second paragraph rejections.

**Applicants’ Response to Rejections Under 35 U.S.C. §102**

Claims 1-3, 6-15 and 18 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,554,712 to Huynh-Tran et al. (hereinafter “Huynh-Tran”). Applicants traverse this rejection.

Application No.: 10/081,564

Amendment and Response dated December 24, 2003

Reply to Office Action of October 3, 2003

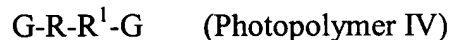
Docket No.: 500-151

Page 9

The Examiner contends that Huynh-Tran discloses compositions which are the reaction product of a urethane polyacrylate, a reactive diluent, and a photoinitiator. The Examiner further contends that Huynh-Tran discloses such compositions having Shore A hardness values below 55 and that these compositions are moldable. Further, the Examiner states that the quantitative ranges of components claimed in the present application are disclosed in Huynh-Tran.

Huynh-Tran fails to disclose each and every element of Applicants' amended claims.

Huynh-Tran is directed to photopolymer compositions used in preparing printing plates. The photopolymer disclosed in Huynh-Tran is a di-functional (meth)acrylated urethane containing chain extending amine groups. In particular, the photopolymer of Huynh-Tran is represented by the formula:



where G is  $\text{CH}_2=\text{C}(\text{R}^9)\text{-C}(\text{:O})\text{-O-R}^8\text{-O-C}(\text{:O})\text{-NH-}$ . (Huynh-Tran; Col. 9, lines 31-46). The di-functionality of the photopolymer is represented by the two acrylate "G" groups. Huynh-Tran does not disclose, teach or suggest the use of mono-functional urethane acrylates.

In contrast, Applicants' amended independent claims 1 and 18 recite a urethane acrylate oligomer, which includes a di- or poly-functional urethane acrylate and a mono-functional urethane acrylate. Because Huynh-Tran fails to disclose mono-functional urethane acrylates, it cannot anticipate Applicants' amended claims.

It is well settled that to be an effective anticipatory reference, a cited document must disclose each and every limitation recited in a claim under examination. Failing such precise disclosure, such a cited document must fail as an anticipatory reference.

Application No.: 10/081,564  
Amendment and Response dated December 24, 2003  
Reply to Office Action of October 3, 2003  
Docket No.: 500-151  
Page 10

Therefore, Huynh-Tran does not anticipate Applicants' amended claims 1 and 18. Because claims 2, 3 and 6-15 depend from claim 1, and thus contain all of the limitations thereof, Huynh-Tran also fails to anticipate these dependent claims.

Moreover, with respect to claim 3 in particular, Huynh-Tran fails to disclose the recited range of components. Huynh-Tran teaches compositions containing 50-100, preferably 70-90, parts by weight photopolymer. Applicants' claim 3, however, recites about 30-47% by weight di-functional urethane acrylate.

In view of the above, Applicants respectfully submit that the Section 102 rejection has been overcome and should be withdrawn.

**Applicants' Response to Rejections Under 35 U.S.C. §103**

Claims 19, 23 and 24 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 5,201,007 to Ward et al. (hereinafter "Ward") in view of Huynh-Tran. Applicants traverse this rejection.

The Examiner contends that Ward discloses a soft tip for use with a hearing aid. The Examiner further contends that the tip of Ward is made from a soft acrylic material. The Examiner acknowledges that Ward fails to teach the use of a urethane acrylate material that corresponds to Applicants' claims. The Examiner asserts, however, that Huynh-Tran discloses materials that correspond to Applicants' claims and that one would have been motivated to construct the tip of Ward from the material of Huynh-Tran.

Ward is directed to an ear mold with an acoustic conduction tube inside and a flanged tip. The ear mold is constructed of silicone, polyvinyl or soft acrylic. As admitted by the Examiner, however, Ward fails to disclose urethane acrylate compositions as in Applicants' claims. As

Application No.: 10/081,564

Amendment and Response dated December 24, 2003

Reply to Office Action of October 3, 2003

Docket No.: 500-151

Page 11

such, Ward fails to teach the urethane acrylate oligomers recited in Applicants' amended claims 19, 23 and 24.

Claims 19, 23 and 24 have been amended to recite a urethane acrylate oligomer, which includes a di- or poly-functional urethane acrylate and a mono-functional urethane acrylate. As discussed in detail above, Huynh-Tran fails to disclose, teach or suggest mono-functional urethane acrylates, and thus, the invention as recited in Applicants' amended claims. As admitted by the Examiner, Ward also fails to disclose, teach or suggest such urethane acrylates. Therefore, Ward fails to cure the deficiencies of Huynh-Tran.

Accordingly, the combination of Ward and Huynh-Tran fails to disclose each and every element of the invention recited in amended claims 19, 23 and 24.

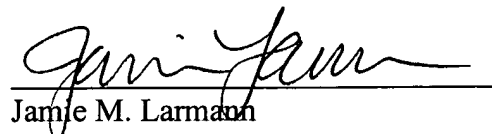
Moreover, Ward and Huynh-Tran are not properly combinable references for an obviousness rejection because they are not analogous art. *See In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992) ("In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."). In particular, Huynh-Tran is directed to water-dispersible polymers applied as layers to printing plates. The objects of the invention relate to printing plates. There is no reason to believe that anyone skilled in Applicants' field of art would look to Huynh-Tran for soft moldable compounds for use in hearing aids. Therefore, Huynh-Tran and Ward are not properly combinable.

In view of the above, amended claims 19, 23 and 24 are not obvious in view of the teachings of Ward in combination with Huynh-Tran. Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection based on this combination.

Application No.: 10/081,564  
Amendment and Response dated December 24, 2003  
Reply to Office Action of October 3, 2003  
Docket No.: 500-151  
Page 12

Applicants' undersigned attorney may be reached by telephone at the number given below. All correspondence should continue to be directed to the address given below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Jamie M. Larman", is written over a horizontal line.

Jamie M. Larman  
Registration No. 48,623  
Attorney for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(973) 331-1700